

REMARKS

Claims 1-13 and 66 remain pending in the application and claims 14-65 were previously withdrawn from consideration. Through this Amendment, claims 1 and 11 have been amended and claim 6 has been canceled. No new matter has been introduced into the application. As explained in more detail below, Applicant submits that all claims are in condition for allowance and respectfully request such action.

Claim Rejections – 35 USC § 103

Claim 66 is rejected under 35 USC § 103(a) as being unpatentable over Storek (US 2004/0259651) in view of Evans (US 3,792,863) as supported by Lagerblade (US 1,444,842). Applicant respectfully traverses the rejection in view of the Remarks below.

Claim 66 recites a “self contained instrumented golf club” that comprises, *inter alia*, “an antenna that comprises a ferrule that connects the head of the golf club to the shaft of the golf club.” The claim is rejected under two arguments – first, that Lagerblade allegedly teaches the antenna, and second, that the recited element would be obvious in view of Applicant’s own disclosure. Applicant respectfully requests reconsideration in view of the following:

Lagerblade does not teach the subject matter as recited. Rather, as acknowledged by the Office Action, Lagerblade merely shows a ferrule that may be used to prevent a shaft from splitting. In this regard, Applicant does not dispute that Lagerblade discloses a ferrule for a golf club. Claim 66, however, does not merely recite a golf club having a ferrule. Rather, claim 66 recites “*an antenna that comprises a ferrule* that connects the head of the golf club to the shaft of the golf club.” (emphasis added). Neither Lagerblade nor any other art of record, however, actually teaches, discloses, or otherwise suggests an antenna that comprises a ferrule connecting the head of the club with the shaft. In this regard, Lagerblade was filed in 1921 and does not teach, disclose, or suggest any electronic component, including a wireless component such as an antenna. In contrast, according to certain claimed embodiments of this application, having a ferrule as at least part of an antenna may allow the use of different head/shaft combinations without requiring rewiring or attachment of an antenna within a new shaft. This is drastically different than the teachings of Lagerblade, which never mentions or suggests any electronic

features, especially an antenna, but rather only teaches a ferrule for structural support. For at least this reasoning, Applicant respectfully requests reconsideration and withdrawal of the rejection in respect to claim 66.

The Office Action further states that the application being examined “explicitly discloses that the shaft can be used as an antenna or the antenna may be plated on to the shaft, grip or any other location... [and t]herefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Storek’s golf club and use any of part of the golf club such as the ferrule as the antenna, *since the Applicant[s] explicitly indicated that different parts of the golf club could be used as the antenna.*” (Office Action dated June 20, 2009, p. 10, emphasis added). Applicant respectfully submits that the Office’s rejection consists of improper hindsight reasoning. As recognized by the MPEP and the precursor court to the Federal Circuit, hindsight reasoning may be used “so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and *does not include knowledge gleaned only from the applicant’s disclosure*, such a reconstruction is proper.” (*See In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971), *see also* M.P.E.P. 707/07(f)). In this regard, Applicant respectfully submits that the Office Action’s rejection only points to the Applicant’s disclosure that “different parts of the club [such as the claimed ferrule] could be used as the antenna.” This subject matter is “gleaned only from the applicant’s disclosure” and is not taught, disclosed, or suggested anywhere within the cited art. If the rejection is maintained, Applicant respectfully requests clarification on where the art teaches, suggests, or discloses this element.

In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection in respect to claim 66.

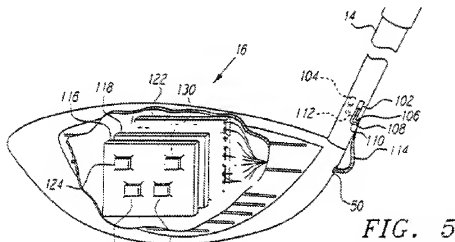
Claims 1-5 and 10-11 are rejected under 35 USC § 103(a) as being unpatentable over Storek (US 2004/0259651) in view of Lee (US 2001/0053720). Applicant respectfully requests reconsideration and withdrawal rejection in view of the Remarks below.

Through this Amendment and Response, claim 1 has been amended to incorporate the subject matter of dependant claim 6. Specifically, claim 1 has been amended to recite “an antenna that comprises a ferrule that connects the head of the golf club to the shaft of the golf

club.” Applicant respectfully submits that claim 1 is therefore allowable for at least the same reasons that claim 66 is allowable. Moreover, Lee actually teaches away from a club where the “antenna that comprises a ferrule that connects the head of the golf club to the shaft of the golf.” Instead, when discussing the region that connects the shaft to the head (and as shown in Fig. 5 of Lee) Lee states:

A thin layer of a flexible polymer (not illustrated), such as *epoxy, is used to bond the wires to the shaft 14* while retaining pliability for flexing of the shaft 14. ...The wires 108, 110 and 112 are drawn together to form a *bundle wire 114 to exit the club head 16 via the inlet 50*. The interior of the club head 16 contains an acceleration board 116, a signal conditioning board for the accelerometers 118 and the strain gauge conditioning board 122.

(Lee, para. 52, ll. 1-3, see also the relevant portion of Fig. 5, pasted immediately below). As seen, there is no ferrule that connects the club shaft to the head, but rather advise routing the bonded and bundled wires around and away from that area.



Likewise, claim 11 has been amended to indicate that the transmission uses “an antenna that comprises a ferrule that detachably connects a head of the golf club to a shaft of the golf club.” As discussed above, neither Storek nor Lee disclose “an antenna that comprises a ferrule.” Moreover, Applicant respectfully submits that neither Stork, Lee, nor Lagerblade teach such a ferrule that “*detachably* connects a head of the golf club to a shaft” as recited in claim 11. (Clearly, the teachings of Lee teach away from such as detachable ferrule because the wires are expressly bonded, then bundled together and physically wired from the shaft to the head). For at

least this reasoning, Applicant respectfully requests reconsideration and withdrawal of the rejection in respect to claim 11 and its dependent claims.

Claim 2, which depends from claim 1, recites a golf club wherein "the weight of the first accelerometer and the second accelerometer do not change the balance or center of gravity of the club." As admitted by the Office Action, neither Storek nor Lee teach this element. (Office Action dated June 20, 2009, p. 3) Despite this, the Office Action states that "it would have been obvious to one of ordinary skill in the art to design the attachments of the accelerometers to not change the center of gravity of [sic] club...[because h]aving the accelerometers so they do not change the balance or center of gravity of the club will allow the user to swing the instrumented golf club as it were a normal golf club." (*Id.*, p. 4).

Applicant respectfully traverses this rejection on two grounds. First, the Office Action admits that this element (and the benefit of this element) is not taught by the alleged art. Instead, the Office Action uses Applicant's own recited benefits (*see, e.g.*, paragraph 30 of the application) as evidence of obviousness. Thus, because the conclusion is "gleaned only from the applicant's disclosure" and is not taught, disclosed, or suggested anywhere within the cited art, Applicant respectfully requests reconsideration and withdrawal of the rejection in respect to claim 2.

Secondly, not only do the two references cited against claim 2 fail to teach the subject matter, but the other art of record (which was previously cited against this claim) teaches away from it. For example, Petrash (previously cited against claim 2) expressly teaches against this element. (*See, e.g.*, Applicant's Appeal Brief dated April 9, 2009, pp. 13-15). Thus, there are no references of record that teach, disclose, or suggest the recited subject matter and at least one reference that teaches away from the subject matter. Applicant, therefore, respectfully requests reconsideration and withdrawal of the rejection in respect to claim 2.

In view of the forgoing, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-5 and 10-11.

Claims 7-8 and 12 are rejected under 35 USC § 103(a) as being unpatentable over Storek (US 2004/0259651) in view of Lee (US 2001/0053720) as applied to claims 1 and 11 above, and further in view of Gedney et al. (US 5,209,483).

Claims 7-8 ultimately depend from claim 1 and claim 12 depends from claim 11. Applicant respectfully submits that the art of record does not teach, disclose, or suggest the subject matter of claims 1 and 11, and, therefore, submit that claims 7-8 and 12 are allowable over the art of record for at least the reasons discussed above in relation to claims 1 and 11. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Claims 9 and 13 are rejected under 35 USC § 103(a) as being unpatentable over Storek (US 2004/0259651) in view of Lee (US 2001/0053720) and in view of Gedney et al. (US 5,209,483) as applied to claims 7 and 12 above, and further in view of McTeigue (US 5,221,088).

Claim 9 ultimately depends from claim 1 and claim 13 ultimately depends from claim 11. Applicant respectfully submits that the art of record does not teach, disclose, or suggest the subject matter of claims 1 and 11, and, therefore, submit that claims 9 and 13 are allowable over the art of record for at least the reasons discussed above in relation to claims 1 and 11. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the rejection.

Claim 6 is rejected under 35 USC § 103(a) as being unpatentable over Storek (US 2004/0259651) in view of Lee (US 2001/0053720) as applied to claim 1, and further in view of Evans (US 3,792,863) as supported by Lagerblade (US 1,444,842).

Through this Amendment and Response, Claim 6 has been cancelled. Applicant, therefore, respectfully requests withdrawal of the rejection.

CONCLUSION

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the number set forth below.

Respectfully submitted,
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Dated: October 2, 2009 By:

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